

REMARKS

Applicant respectfully requests reconsideration of the instant application in view of the amendments, herein, and the following remarks:

The following claims are *pending*: 1-10.

The following claims are *independent*: 1.

Please *amend* claim 1; although these claims have been amended herein to provide clarification, correct typographical inaccuracies and/or informalities, and/or to better track practical/commercial implementations/practices (hereinafter “amendment,” “amendments,” and/or “amended”), Applicant submits that the originally filed claims are patentable and reserves the right to pursue the originally filed claims (as well as any claims dependent therefrom) at a later time and/or in one or more continuation/divisional application(s). Applicant submits that these new claims and/or claim amendments are supported throughout the originally filed specification and that no new matter has been added by way of these amendments.

Claim Rejections - 35 U.S.C. § 112

The Office Action rejected claim 2 under 35 U.S.C. § 112, first paragraph, as allegedly being indefinite, claiming “the recitation, ‘the entity is not a public corporation’...is not described and not found in specification or in original claims” (Office Action, p. 2, §4). MPEP § 2163 prescribes that, “If a skilled artisan would have understood the inventor to be in

possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate description requirement is met." Applicant notes that, by way of non-limiting example, paragraph 0059 recites, "In one example, the entity may be a public corporation." Applicant submits that, based at least in part on this aspect of the original disclosure, one of ordinary skill in the art would recognize that Applicant was in possession of the claimed matter as recited by claim 7. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection and allowance of the claim.

Applicant further submits that the pending rejection has not set forth a *prima facie* showing of lack of written description. MPEP § 2163 specifies that an evaluation of the adequacy of written description requires the Examiner to "For Each Claim, Determine What the Claim as a Whole Covers," "Review the Entire Application to Understand How Applicant Provides Support for the Claimed Invention Including Each Element and/or Step," and "Determine Whether There is Sufficient Written Description to Inform a Skilled Artisan That Applicant was in Possession of the Claimed Invention as a Whole at the Time the Application Was Filed." Applicant submits that the pending rejection has provided no indication of the aforementioned factors of a *prima facie* showing of lack of written description. Instead, the pending rejection has merely asserted that claim elements in question are allegedly "not described and not found in the specification or in original claims," and that they are therefore, "considered a new matter" (Office Action, p. 2, § 4). However, the MPEP explicitly states that, "The examiner has the initial burden of presenting evidence or reasoning to explain why persons skilled in the art would not recognize in the original disclosure a description of the invention defined by the claims" (§ 2163; emphasis added). Applicant respectfully submits

that "the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed" (MPEP § 2163.02). Furthermore, Applicant submits that the allegations set forth in the pending rejection are not sufficient to constitute satisfaction of the Examiner's "initial burden of presenting evidence or reasoning to explain why persons skilled in the art would not recognize in the original disclosure a description of the invention defined by the claims," as required by the MPEP. As a *prima facie* showing of written description has not been set forth, Applicant respectfully requests reconsideration and withdrawal of this basis of rejections. Should the Examiner maintain the rejection, Applicant respectfully request that all factors prescribed by MPEP § 2163 in support of a showing of lack of written description be explicitly discussed by the Examiner, so that Applicant can better understand the "evidence or reasoning" underlying the Examiner's assertion of lack of written description and provide a full response at the earliest opportunity.

The Office Action further rejected claims 1-10 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Applicant has amended the claims to provide further clarification and/or improve form. For example, independent claim 1 recites, *inter alia*, "iteratively changing, with the computer system, a value of a debt/equity ratio associated with an entity based on at least one simulation." Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejections and allowance of the claims.

Claim Rejections - 35 U.S.C. § 103

The Office Action rejected claims 1-10 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Ichihari et al , US Patent Application No. 2003/0046203 (hereinafter “Ichihari”), and in further view of Vass, US Patent No. 7,251,627 (hereinafter “Vass”).

Although Applicant respectfully traverses the rejection and submits a *prima facie* showing of obviousness has not been established, and that the applied references, taken both individually and in combination, fail to discuss or render obvious every element of each pending claim, Applicant has amended the claims to provide further clarification and/or to improve form.

Independent claim 1 recites, *inter alia*,

A method implemented by a programmed computer system comprising:

...
calculating...a plurality of values of earnings per share associated with the entity based at least in part upon the debt/equity ratio, including anticipated conversion of one or more convertible securities;

...

The Office Action asserts, “Ichihari discloses...calculating...values of earnings per share associated with the entity based at least in part upon the second debt/equity ratio values for that entity (para 0081; via step 108 in Fig. 1 and Fig. 10 with simulation graph” (Office Action, p. 3-4, §8). Applicant respectfully disagrees and submits that Ichihari discusses calculating “the probability distribution of ROI (return on invested capital)” (Ichihari, ¶0081), rather than the claimed “calculating...a plurality of values of earnings per share associated with the entity based at least in part upon the debt/equity ratio, including anticipated conversion of one or more convertible securities,” as recited in

independent claim 1. Furthermore, Applicant submits that Ichihari makes no mention of convertible securities whatsoever, and thus plainly fails to discuss or render obvious at least the claim elements discussed above. Similarly, Applicant submits that Vass' identification of stocks for a portfolio fails to remedy the deficiencies identified in Ichihari with regard to independent claim 1. Accordingly, Applicant submits that the applied references, taken both individually and in combination, fail to discuss or render obvious at least the claim elements discussed above, and respectfully requests reconsideration and withdrawal of the rejections, and allowance of the claims.

Should the Examiner maintain the rejection, Applicant respectfully requests clarification as to how and specifically where the Examiner believes Ichihari allegedly discusses the claimed, "convertible securities," "anticipated conversion of one or more convertible securities," and "calculating...a plurality of values of earnings per share associated with the entity based at least in part upon the debt/equity ratio, including anticipated conversion of one or more convertible securities," as recited in independent claim 1.

Applicant further submits that claims 2-10, which depend directly or indirectly from independent claim 1, are all also patentable over Ichihari and Vass, taken both individually and in combination, for at least similar reasons as those discussed above identifying deficiencies in Ichihari and Vass in regard to independent claim 1. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejections, and allowance of the claims.

CONCLUSION

Applicant asserts that the above remarks, which distinguish the claims over the cited reference(s), pertained only to noted claim element portions. These remarks are believed to be sufficient to overcome the prior art to this Office Action (and/or any previous office action(s)) (hereinafter “Office Action(s)”). While many other claim elements and/or bases for rejection were not discussed, as they have been rendered moot based on the above amendments and/or remarks, Applicant asserts that all such remaining and not discussed claim elements and/or bases for rejection, all, also are distinguished over the prior art, and Applicant reserves the opportunity to more particularly traverse, remark and/or distinguish over any such remaining claim elements and/or bases for rejection at a later time, should it become necessary. Further, any remarks that were made in response to the Office Action(s)’ objection and/or rejection as to any one claim element, and which may have been re-asserted as applying to other Office Action(s) objection(s) and/or rejection(s) as to any other claim element(s), any such re-assertion(s) of remarks are not meant to imply that there is commonality about the structure, functionality, means, operation, and/or scope of any of the claim element(s), and no such commonality is admitted as a consequence of any such re-assertion(s) of remarks. Consequently, the reference(s) cited the Office Action(s) do not result in the claimed invention(s), there was/is no motivation, basis and/or rationale for such a combination of references (i.e., cited references do not teach, read on, suggest, or result in the claimed invention(s)), and the claimed invention(s) are not admitted to be prior art. Also, Applicant does not accept, admit, and/or concede to any assertions, (mis)characterizations (e.g., of claims, references, and/or otherwise), and/or Official Notice(s) in the Office Action(s). As such, Applicant does not concede that any claim element(s) have been

anticipated and/or rendered obvious by any of the cited reference(s) and/or any Official Notice in the Office Action(s). Thus, the Applicant respectfully submits that the supporting remarks and claimed inventions, claims 1-10, all: overcome all rejections and/or objections as noted in the Office Action(s), are patentable over and discriminated from the cited reference(s), and are in a condition for allowance. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection(s) and/or objection(s), and allowance of all claims.

Authorization

Applicant hereby authorizes and requests that the Commissioner charge any additional fees that may be required for consideration of this and/or any accompanying and/or necessary papers to Deposit Account No. 03-1240, Order No. 17209-503. In the event that an extension of time is required (or which may be required in addition to that requested in a petition for an extension of time), Applicant requests that the Commissioner grant a petition for an extension of time required to make this response timely, and, Applicant hereby authorizes and requests that the Commissioner charge any fee or credit any overpayment for such an extension of time to Deposit Account No. 03-1240, Order No. 17209-503.

In the event that a telephone conference would facilitate examination of the application in any way, Applicant invites the Examiner to contact the undersigned at the number provided.

Respectfully submitted,
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